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09/839,138	04/23/2001	Masaki Hiraga	1341.1091/JDH	1608
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EXAMINER NGUYEN, TRI V				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

09/839,138

Applicant(s)

HIRAGA, MASAKI

Examiner

TRI V. NGUYEN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-13, 16, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 16, 22, 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Upon the amendment filed on 04/15/08, Claims 1-8, 11-13, 16 and 22 are amended and Claim 23 is cancelled. The currently pending claims considered below are Claims 1-8, 11-13, 16, 22 and 23.

In view of the amendments and remarks, the 102(e) rejections under Ng is withdrawn.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-3, 8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng in view of Davis et al. (US 2006/0143095).

Ng teaches a method of allowing users to submit (corrected) searches on products and receive rewards once a second user utilizes the original search. The overall scheme is funded via advertisements.

Claim 1: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. presenting a first set of keywords to a first user through a network (col 6, lines 37 - 45 -- the presentation of categories for products is commensurate to the presentation of keywords);
- b. accepting, from the first user, a selection of at least one of the first set of keywords presented to the first user (col 6, lines 37 - 45);
- c. storing, in a first table, the at least one keyword selected from the presented

keywords as is related to the first user (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords);

- d. presenting a second set of keywords to an advertiser through the network;
- e. accepting, from the advertiser, a selection of at least one of the second set of keywords presented to the advertiser;
- f. storing, in a second table, the at least one keyword selected by the advertiser as is related to the advertiser;
- g. In response to a reception of a request for the search from the second user different from the first user through the network, searching the first table and the second table for keywords specified in the request for the search, and when any of the specified keywords is found both in the first table and the second table, sending results of the search along with an advertisement associated with at least one keyword in the second table to the second user through the network (col 8, lines 33-49); and
- h. giving points to the first user when the second user has referred to the advertisement, by storing the points as related to the first user in a third table which keeps point information for each user (col 8, lines 33-49).

Ng does not explicitly disclose the database management and the steps of interacting with the advertiser and displaying the advertisement along with the search results. Ng discloses the use of databases and targeted advertising in conjunction with the products and services listed and searched (col 15, lines 43-60). Furthermore, Ng teach the feature of a user being rewarded for an advertisement being viewed by a second user (col. 14, lines 52-63 and claim 4). Official notice is taken that it would have been well within the purview of a skill artisan at the time of the inventions to implement the method to a database architecture. In an analogous art, Davis et al recites the features of targeted advertisement being displayed on a search result web page and

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specific keywords being presented and selected by the advertiser (abstract, Figs 1, 2 , 9 and parag. 48- 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchases the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. The claim would have been obvious because the technique for improving a particular method was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Claim 2: Ng and Davis et al disclose the method of providing points according to claim 1, wherein the points gained by the first user are exchanged for a product or a service (Ng: col 9, lines 23-29).

Claim 3: Ng and Davis et al disclose the method of providing points according to claim 1, wherein the points given to the first user comprise user points that are generated when the result of the search using the specified keywords is sent and advertiser points that are generated when the second user has referred to the advertisement (Ng: col 5, lines 4-9). In an analogous art, Davis et al. also disclose the rewarding based on the number of click-throughs (parag. 11, 13, 96 and 98). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught with an accounting system via a per view basis. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claim 8: Ng and Davis et al disclose the method of providing points according claim 1, but do not explicitly disclose wherein a user who has registered at least one keyword can select a display on a user's terminal or a transmission by e-mail as a method of presenting the advertisement to the other users. Davis et al discloses the use of web page as a display means (abstract and parag. 48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al, with displaying the advertisement via a web page since it was known in the art that different display channels are used to enhance the ways to reach the users. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claims 12 and 13 disclose the apparatus and the computer readable medium of the method Claim 1 respectively. The prior art of et al. as set forth above in Claim1 is relied upon to reject Claims 12 and 13.

4. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng and Davis et al as applied to claim 1 above, and further in view of Marks et al. (US 2001/0051911).

Claims 4-7: Ng and Davis et al disclose the method of providing points according to claim 1, but do not explicitly disclose the various ways of charging for the keywords. Ng recites the use of heuristic rules to improve the obtained results (col 11, lines 43-60). Davis et al discloses an accounting manager to maintain the records of the transactions and the compensation information (abstract, element 22 in Fig 1 and Fig 2). In an analogous art, Marks et al. recites the use of keyword advertising by associating an ad with specific keywords chosen by the

advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). Furthermore, the fee structure is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al to include a fee structure for charging the keywords. One would have been motivated to implement a payment scheme in order to attract advertisers by giving the advertisers a decision choice depending on the revenue, viewing experience and traffic stream pattern. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

5. Claims 11, 16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al in view of Ng.

Claim 11: Davis et al discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. In response to a reception of request for a search from a first user, displaying retrieved results the search with an advertisement of an advertiser associated with a keyword having been selected by the advertiser and used for the search at a first user's terminal (abstract and parag. 48-60); and
- b. When the first user follows a link set to the advertisement to visit an advertiser's site of the advertisement, giving points to a second user who is different from the first user and has selected any of the keywords associated with the advertisement (parag. 11, 13, 96 and 98).

Davis et al does not explicitly disclose the feature of a points rewarding system. Davis et al discloses compensating a third party for helping in the advertisement display (abstract). In an

analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Davis et al with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claim 16 discloses the computer readable medium of the method Claim 11. The prior art of Davis et al and Ng as set forth above in Claim 11 is relied upon to reject Claim 16.

Claim 22: Davis et al. disclose a method of providing points based on a retrieval of keywords in a website, the method comprising:

- a. in response to a request for the search by a first user, providing the first user with results of the search along with an advertisement of an advertiser associated with a keyword having been selected by the advertiser and used for the search (abstract and parag. 48-60); and
- b. in response to the providing the first user with the results, giving at least one point to a second user who is different from the first user and has registered any of the keywords used for the search to the web site.

Davis et al does not explicitly disclose step points rewarding system. Davis et al discloses compensating a third party for helping in the advertisement display (abstract). In an analogous

art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line51 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Davis et al with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchases the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claim 23: Ng and Davis disclose the method of providing points according to the claim 22, further comprising, when the first user follows a link set to the advertisement to visit an advertiser's site of the advertisement, giving points to a second user who is different from the first user and has registered any of the keywords associated with the advertisement (Davis et al.: parag. 11, 13, 96 and 98). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (; col 5, line 21 to col 6, line51 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Davis et al with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchases the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Response to Arguments

6. Applicant's arguments filed on 04/15/08 have been fully considered but they are not persuasive.

Regarding applicants' argument that the category listing is not commensurate to a keyword and the association of advertiser to keyword (page 8 et seq.), the examiner respectfully disagrees as both Ng and Davis et al. references disclose the features of a search engine and search terms input thus the search term is construed as a keyword. At the onset, it is noted that the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) Hence, in the broadest reasonable interpretation of the instant claims, Ng teaches a first user being presented a category listing (a keyword), the first user further provides information about a product associated with the selected category and is rewarded once a second user has viewed the information regarding the product listed in the category - thus the category is an underlying keyword that is selected by the first user and is not seen as being

diverging from the concept of a keyword having to be the product. Furthermore, the advertising features is taught by Ng - see claim 4 wherein a person is rewarded for advertisement viewed; col 14, line 53 et seq. in which advertising revenue are used to fund the database and col 15, line 43 et seq. in which targeted advertising is implemented. It would have obvious to a skilled artisan at the time the invention was made that a consumer interested in a specific brand of products and categories would inputs brands, products and/or in a search engine and that the entries are keywords and that the advertiser would sponsor its own products. Furthermore, the Davis et al. reference is relied upon to teach the association of keywords and advertisements with advertising revenues being generated via click-throughs.

A second reasonable interpretation of the instant claims is also taught by Ng in which a user is rewarded for correcting the entries regarding a product. Here, the user is presented a list of products (or keywords), select one that the user wants to correct and is rewarded if another user view the corrected information. Again, the advertising features are taught by Ng and Davis et al.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./
Examiner, Art Unit 1796
July 8, 2008

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622